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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/654,735	09/05/2000	Donald R. Titterington	D/A0306II	8428

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EXAMINER

SERGEANT, RABON A

ART UNIT PAPER NUMBER

1711

DATE MAILED: 06/17/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/654,735

Applicant(s)

TITTERINGTON ET AL.

Examiner

Rabon Sergent

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 07 April 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-20 and 39-44 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 and 39-44 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

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1. Claims 43 and 44 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The structure is incorrect, because a bonded hydrogen is missing from one of the urethane nitrogen atoms.

2. Claims 39-44 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The language, "selected from among", is not accepted Markush language. Markush groups are, by definition, closed to the inclusion of additional species; however, it is not clear from applicants' language if the group is closed to the inclusion of other species.

3. Claims 6-15 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Applicants have provided enablement only for the use and production of non-polymeric urethanes; however, it is unclear that applicants' claimed urethanes exclude polymeric products. Contrary to applicants' response, the claims have not been amended to address the rejection.

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4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 6-12, 15, and 39-44 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 36-38 and 43-45 of copending Application No. 09/078,190. Although the conflicting claims are not identical, they are not patentably distinct from each other because each claim set is drawn to a phase change ink composition comprising a urethane derived from a fused ring alcohol.

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This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

6. Claims 1-20 and 39-44 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-58 of U.S. Patent No. 5,994,453. Although the conflicting claims are not identical, they are not patentably distinct from each other because each claim set is drawn to a phase change ink composition comprising a urethane derived from a fused ring alcohol.
7. Claims 6-12, 15, and 39-44 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 4, 5, 16, and 17 of U.S. Patent No. 5,750,604. Although the conflicting claims are not identical, they are not patentably distinct from each other because each claim set is drawn to a phase change ink composition comprising a urethane derived from a fused ring alcohol.
8. Claims 6-12, 15, and 39-44 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 4 and 5 of U.S. Patent No. 5,782,966. Although the conflicting claims are not identical, they are not patentably distinct from each other because each claim set is drawn to a phase change ink composition comprising a urethane derived from a fused ring alcohol.
9. Claims 6-12, 15, and 39-44 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 5, 6, 11, 12, 23, 24, 29, and

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30 of U.S. Patent No. 5,783,658. Although the conflicting claims are not identical, they are not patentably distinct from each other because each claim set is drawn to a phase change ink composition comprising a urethane derived from a fused ring alcohol.

10. Claims 6-12, 15, and 39-44 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4 and 27-29 of U.S. Patent No. 5,827,918. Although the conflicting claims are not identical, they are not patentably distinct from each other because each claim set is drawn to a phase change ink composition comprising a urethane derived from a fused ring alcohol.


11. Claims 6-12, 15, and 39-44 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4, 6-10, 16, 17, 23-30, 33, 35-39, 49, and 50 of U.S. Patent No. 5,830,942. Although the conflicting claims are not identical, they are not patentably distinct from each other because each claim set is drawn to a phase change ink composition comprising a urethane derived from a fused ring alcohol.

12. Claims 6-12, 15, and 39-44 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 9, 10, 13, 14, 32, 33, 36, and 37 of U.S. Patent No. 5,919,839. Although the conflicting claims are not identical, they are not patentably distinct from each other because each claim set is drawn to a phase change ink composition comprising a urethane derived from a fused ring alcohol.

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13. Claims 1-20 and 39-44 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 8, 9, 12, and 34 of U.S. Patent No. 6,057,399. Although the conflicting claims are not identical, they are not patentably distinct from each other because each claim set is drawn to a phase change ink composition comprising a urethane derived from a fused ring alcohol.

Any inquiry concerning this communication should be directed to R. Sergent at telephone number (703) 308-2982.

  
**RABON SERGENT**  
**PRIMARY EXAMINER**

R. Sergent

June 14, 2003